

REMARKS

The Claims

Claims 1-10 and 16-20 are pending in this application. Claims 11-15 are withdrawn from consideration as being directed to a non-elected invention. Claims 3-10 and 16-20 were objected to, but were indicated to be allowable if rewritten in independent form.

The Rejection

The Examiner rejected Claims 1 and 2 under 35 USC 102(b) as being anticipated by the description of the background of the present invention as set forth in at pages 1-10 and in Figures 1-6 of the present application.

In response to the Applicant's arguments filed on November 24, 2006 the Examiner stated "The prior art discusses at length pages 1-10 figures 1-6 the construction of prior art suppressors made of molded epoxy binder with iron particles (chosen for its excellent absorption qualities) and ceramic (insulation properties) inner sleeves. There is no reason the inner sleeve and outer shell need be of different material though as the limitations of claim 1 are now recited."

The first part of the Examiner's statement is a clearly erroneous description of the known radiation suppressor used on industrial magnetrons. The known suppressor is formed of a molded, collar-shaped piece of a radiation suppressing material and a metallic contact for attaching an electrical lead. See, pages 6-7, paragraphs 0011 and 0012, and Figures 5 and 6 of the present application. *There is no ceramic inner sleeve in the known radiation suppressor.* The dome (208) of the magnetron is made of a ceramic material and there is a ceramic insulator disposed between the cathode connector (204) and the anode in the magnetron. See, page 4, paragraph 0007; page 5, paragraph 0008; and Figures 2 and 3 of the present application. However, neither of those ceramic pieces is a part of the radiation suppressor. Nor does either of

those pieces perform a radiation suppression function.

From the second part of the Examiner's response, it appears that the Examiner interpreted original Claim 1 as not excluding the use of the known radiation suppression material in the inner sleeve because a portion of that material may provide electrical insulation. Claim 1 has been amended to recite that the inner sleeve consists of an electrical insulating material. It is well-settled that the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in a claim. MPEP §2111.03. Therefore, it should now be clear that the Applicant's claimed radiation suppressor has an inner sleeve and an outer shell that are made of two different materials. The inner sleeve is formed only of an electrically insulating material and the outer shell is formed of a material that absorbs RF radiation. There is nothing in the Background section of the present application that describes or suggests such a combination of features.

In order for a reference to anticipate a claimed invention, it must describe every element of the claimed invention. MPEP §2131. The background section (pages 1-10) of the present application and the related drawings (Figures 1-6) do not describe or show an RF radiation suppressor for a magnetron that has the combination of features set forth in Claim 1. Accordingly, the alleged "admitted prior art" relied on by the Examiner does not raise a *prima facie* case of anticipation relative to Claim 1.

Claims 2 depends from Claim 1 and thus, includes all of the features of Claim 1. Therefore, Claim 2 is novel for at least the same reasons as Claim 1.

For all of these reasons, the rejection of Claims 1 and 2 under 35 USC 102(b) is believed to be overcome because it is not supported by substantial evidence of unpatentability. Therefore, the rejection should be withdrawn.

Allowable Subject Matter

The Examiner objected to Claims 3-20 for being dependent upon a rejected base claim. He further indicated that those claims would be allowable if amended to include all of the features of the base claim and any intervening claim(s).

The Applicant notes that Claim 16 is an independent claim. Therefore, the Examiner's statement is not consistent with the claims as presented in this application. Although this appears to be an oversight, it makes the record of this application unclear as to the status of Claim 16 and any claim that depends upon Claim 16.

Comments Pursuant to 37 CFR 1.116

The Applicant believes that the amendment to Claim 1 is necessary to more clearly point out the subject matter that the Applicant considers to be his invention. It is believed that the clarifying amendment also shows how the Applicant's claimed RF radiation suppressor is novel relative to the known suppressor described in the Background section of the present application.

The amendment could not be submitted earlier because it was unclear from either of the non-final actions of February 24, 2006 and September 12, 2006 how the Examiner was interpreting the claims or the alleged "admitted prior art." For example, in the action mailed on February 24, 2006 the Examiner stated only the following: "Claims 1-3, 6-8 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the admitted prior art shown in figures 1-6 and pages 1-10 of the specification." That statement is so vague that the Applicant could not properly respond to it. In the response filed on May 24, 2006, the Applicant pointed out the vagueness of the rejection and requested that the Examiner indicate more specifically what drawing figure and text he was referring to so that the Applicant could consider the alleged disclosure and respond accordingly.

In the non-final action mailed on September 12, 2006, the Examiner withdrew the rejections of Claims 3-20, but maintained the rejection as to Claims 1 and 2. In making the rejection the Examiner stated "Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the admitted prior art shown in figures 1-6 and pages 1-10 of the specification." In response to the Applicant's arguments that the specification does not describe a two-piece radiation suppressor for a magnetron the Examiner stated "Applicant's argument that figure's [sic] 1-6 do not show at least a two part magnetron [sic] as is well known in the art please read pages 1-10 of the specification regarding the construction of a typical magnetron using ceramics and metallic construction."

On November 1, 2006, the Applicant's attorney contacted the Examiner by telephone in an attempt to obtain a clarification of the basis for the rejection and a more specific indication of what portions of the specification the Examiner was relying on as describing a two-piece radiation suppressor as set forth in the rejected claims. The Examiner could not specify the particular text or drawings he had relied on and invited the Applicant's attorney to file a response pointing out the differences between the claimed radiation suppressor and the known suppressor as described in the Background section of the specification.

In the response submitted on November 24, 2006, the Applicant again tried to point out the differences between the claimed radiation suppressor and the known suppressor described in the Background section of the specification. Reference was made to the telephone interview of November 1, 2006.

In the Official Action mailed on February 20, 2007, the Examiner maintained the rejection of Claims 1 and 2 under Section 102(b), but finally provided a clearer explanation of the basis for the rejection. However, the Examiner made the action final, thereby cutting off

Applicant's ability to amend the claims to distinguish the claimed invention from the cited devices. If the Examiner had provided a proper explanation of the basis for the rejection under Section 102 in either of the non-final actions on the merits, then the Applicant could have submitted an appropriate amendment earlier in the prosecution process.

MPEP §706 states in pertinent part:

After the application has been read and the claimed invention understood, a prior art search for the claimed invention is made. With the results of the prior art search, including any references provided by the applicant, the patent application should be reviewed and analyzed in conjunction with the state of the prior art to determine whether the claims define a useful, novel, nonobvious, and enabled invention that has been clearly described in the specification. *The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.* (Emphasis added.)

Before a final action is proper, there should be a clear issue developed between the Examiner and Applicant. MPEP §706.07 The failure of the Examiner to provide a clear basis for the rejection in the non-final actions and failing to set forth a clear basis for the rejection until the final rejection defeats the goal of reaching a clearly defined issue for either an allowance of the application or a final rejection.

Applicant acknowledges that the Patent Office rules do not give to an applicant the right to amend as often as the examiner presents new references or reasons for rejection. However, the Office's practice does not sanction hasty final rejections either. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. *Id.*

In the present case, the Applicant has diligently sought clarification of the basis for the

rejection under Section 102 so that he could provide an appropriate response. The Applicant has also diligently sought to point out the patentable differences in his claimed invention relative to the known devices as understood by him and described in his own specification, the only reference cited against the claims. The clarification of the basis for the lack of novelty rejection was not forthcoming until the final rejection. Cutting off the Applicant's ability to amend the claims under the circumstances of this case is manifestly unfair.

CONCLUSION

For all of the foregoing reasons, it is respectfully requested that the finality of the action mailed on February 20, 2007 be withdrawn and that the amendment to Claim 1 be entered and considered.

Respectfully submitted,

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